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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,949	10/23/2000	Paul Price	0942.4120005/RWE/BJD	5489

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EXAMINER
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COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 12/31/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693,949

Examiner

Susan Coe

Applicant(s)

PRICE ET AL.

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18-21, 26, 29-32 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18-21, 26, 29-32 and 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 15 & 17
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The amendment filed October 15, 2002 has been received and entered.
2. Claim 33 has been cancelled.
3. Claims 1-13, 18-21, 26, 29-32, and 34-40 are pending.
4. In Paper No. 7, dated September 17, 2001, applicant elected without traverse lipoic acid for species A, myristate for species B, stigmastanol for species C, mammalian cells for species D, and potato for species E. Stigmastanol is not a known potato sterol or known to be used in cell culture media. Therefore, another species, stigmasterol, was selected for examination.
5. Claims 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7. These claims are not considered to read on the elected species because they require two lipids or fatty acids while only one fatty acid (myristate) was elected.
6. Claims 1-13, 18-21, 26, 29-32, and 34-38 are examined on the merits.

### *Double Patenting*

7. Claims 1-13, 18-21, 26, 29-32, and 34-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all of the claims of U.S. Patent No. 6,103,529 for the reasons set forth on page 3 of the previous Office action.

The examiner acknowledges applicant's intent to file a terminal disclaimer on the indication of allowable subject matter. However, until the terminal disclaimer is filed, this rejection is still considered valid.

***Claim Rejections - 35 USC § 102***

8. Claims 1, 2, 12, 13, 26, and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by DIFCO manual (1984) in light of Dyas et al. (Phytochemistry (1994), vol. 35, no. 3, pp. 655-660) for the reasons set forth on pages 3 and 4 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the DIFCO manual does not anticipate the stated claims because it does not teach that the potato agar can be used to cultivate animal cells. However, the use of applicant's agar to cultivate animal cells is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Specifically, applicant's claims are drawn to a culture medium that contains peptides and fatty acids derived from potato. The DIFCO agar contains these materials. Therefore, the DIFCO agar must have the same capabilities as applicant's agar if applicant's agar functions as claimed. If additional ingredients are needed to support the cultivation of animal cells, then applicant's claims must be missing key elements.

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***Claim Rejections - 35 USC § 103***

9. Claims 1-5, 8-13, 26, 29-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over DIFCO manual (1984) in light of Dyas et al. in view of Gibco BRL Life Technologies, Gaithersburg, MD, 1993-1994 Catalogue and Reference Guide pp. 1-105 through 1-107, 1-115 through 1-116, 1-123, 4-49, 4-50, 4-61, and 4-63 for the reasons set forth on page 4 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that there is no motivation in the references to add lipoic acid and myristate to the culture medium taught by DIFCO. However, the motivation to add these ingredients is found by what would be known by a person of ordinary skill in the art. A person of ordinary skill in the art would expect that culture media can be modified by adding different ingredients to the media. This is a routine practice in the art. The Gibco catalog illustrates that lipoic acid and myristate are ingredients that can be used to formulate medium. Therefore, it would have been obvious to add these ingredients to the DIFCO medium based on what was known in the art at the time of the invention.

10. Claims 1-13, 18-21, 26, 29-32, and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,122,469 in view of Dyas et al. (Phytochemistry (1994), vol. 35, no. 3, pp. 655-660) and Gibco BRL Life Technologies, Gaithersburg, MD, 1993-1994 Catalogue and Reference Guide pp. 1-105 through 1-107, 1-115 through 1-116, 1-123, 4-49, 4-50, 4-61, and 4-63 for the reasons set forth on pages 4-6 of the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that US '469 does not teach using peptone,

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lipids, and lipoic acid for the same purpose. However, the patent clearly states that their inventive serum media can contain lipoic acid, peptone, and lipids. Therefore, the patent clearly encompasses a culture medium for the cultivation of mammal cells that contains all of these ingredients.

Applicant also argues that there is no motivation to derive peptides and lipids from potato. However, US '469 does teach using a plant source to provide peptides and lipids. Potato would have peptides and lipids. In addition, since applicant's claims are drawn to composition claims and not drawn to methods of making a culture medium, the source of the plant peptides and lipids would not lend a patentable difference as long as the claimed elements are present in the reference. As stated above, US '469 teaches using plant lipids and peptides; therefore, the claimed limitations are met.

In addition, applicant argues that there is no motivation to add the ingredients taught by the Gibco catalog to the medium of US '469. However, there is considered to be sufficient motivation based on what was known in the art. See paragraph 9 above.

11. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner  
December 27, 2002



LEON B. LANKFORD, JR.  
PRIMARY EXAMINER